

REMARKS

I. Disposition of the Claims

Claims 71, 74-85, and 87-138 are pending. Claims 72-73 and 86 have been cancelled without prejudice or disclaimer. Claim 71 has been amended. Claims 101-116 have been elected with traverse. Claims 71, 74-85, 87-100, and 117-138 should be examined.

Support for amended claim 71 is in the as-filed specification, e.g., claim 3.

II. Response to the Restriction Requirement

Applicants hereby provisionally elect Group III, Claims 101-116, for examination, with traverse. All pending claims should be examined as the restriction is improper.

For all national stage filings of international applications, restriction requirements must comport to the unity of invention standard. 37 C.F.R. §1.475. This application is the national phase of International Application No. PCT/FR99/00363. Thus, the present restriction requirement should be tested under the unity of invention standard.

The restriction requirement divides the claims into eight groups:

Group I Claim(s) 70-94 are drawn to method of use of aromatic compound of formula $\text{ArCH}_2\text{A}'\text{F}_a$ wherein each **Ar**, **CH₂A'** and **F_a** are as defined.

Group II Claims 95-100 drawn to triphenyl compound of formula $\text{ArCH}_2\text{A}'\text{F}_a$ wherein each **Ar**, **CH₂A'** and **F_a** are as defined.

Group III Claims 101-116 drawn to di-trisubstituted triphenyl compound wherein each **Ar**, **CH₂A'** and **F_a** are as defined.

Group IV Claims 117-121 and 123-132 drawn to methods of preparing trisubstituted triphenyl compound

Group V Claim 122 is drawn to a second method of preparing trisubstituted triphenyl compounds

Group VI Claims 133-136 drawn to a medicament and pharmaceutical preparation

Group VII Claim 137 drawn to a compound made by method of claim 117

Group VIII Claim 138 drawn to a compound made by the method of claim 122

Office action, p. 3. Furthermore, according to the Examiner, the groups “lack the same or corresponding special technical features [because] they do not share the same essential structural element(s) that define the ‘special technical feature’ necessary to specify a contribution over the prior art.” *Id.* Yet the grouping of the present version of the claims and the reasons for restricting conflict with the guidelines for determining whether a set of claims has unity of invention.

According to PTO guidelines, the unity of invention is first tested on the independent claims. Annex B, Unity of Invention, The Instructions Concerning unity of Invention, pp. AI-53—AI-57 (enclosed for consideration). Independent claims standing in a genus/species relation, if free of the prior art, have unity of invention. Annex B, *supra*, p. AI-53.

For example, in this case, independent claims 95 and 101 have a genus/species relation. Claim 95 recites: “[a] triphenyl compound substituted with a hydrocarbon substituent of formula $\text{CH}_2\text{A}'\text{F}_a$,” and claim 101 recites “[a] di- or trisubstituted triphenyl compound,

comprising ... a hydrocarbon substituent of formula $\text{CH}_2\text{A}'\text{F}_a$." Claim 95 may be considered a genus embracing the compound of claim 101. Thus, the genus/species relation of claims 95 and 101 impart unity of invention to these claims if they are free of the prior art. And indeed, they are free of the prior art according to the evidence and explanation of record.

Furthermore, if the independent claims are free of the prior art, then both the independent claim and its depend claims have unity of invention. So, not only do claims 95 and 101 have unity of invention, but their dependent claims 96-100 and 102-115 have it too. Since claims 95-116 have unity of invention and form the restriction requirement's Groups II-III, both Groups II-III should be rejoined and examined together.

In addition to regrouping Groups II-III together, the remaining claims should be rejoined. Indeed, a compound, making the compound, and using the compound may have unity of invention. For example, unity of invention exists for the following claims:

- A. A method of making chemical substance X.
- B. Substance X.
- C. Using substance X.

Annex B, supra, p. AI-57. Claims A-C have unity of invention, because the chemical substance X is a common technical feature.

Similarly in this application, a common technical feature and thus unity of invention exists for the present independent claims 71, 95, and 117. Present claim 71 is analogous to the Example's claim C, since both claims concern using a substance. Present claim 95 is analogous to the Example's claim B, since both claims concern a substance. Present claim 117 is analogous to the Example's claim A, since each claim concerns making a substance. As the Example's claims A-C recite the same chemical substance X and thus share a common

technical feature, present claims 71, 95, and 117 recite the same triphenyl compound and thus share a common technical feature. As the Example's claims A-C have unity of invention, claims 71, 95, and 117 have unity of invention.

Furthermore, a similar analysis may be made for present independent claims 101 (compound) and 122 (making). They share a common technical feature and thus have unity of invention. And since, as discussed above, claim 101 has unity of invention with claim 95, claims 122 and 95 have unity of invention.

Because claims 71, 95, 101, 117, and 122 have unity of invention, so do their dependent claims. In other words, every claim in this application has unity of invention and must be examined under PTO guidelines.

In summary, the evidence and explanation shows that the restriction is improper and should be withdrawn.

Respectfully submitted,

Date 12/3/12

By 

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 295-4166
Facsimile: (202) 672-5399

Sean A. Passino
Attorney for Applicant
Registration No. 45,943

Enclosure: Annex B, Unity of Invention, The Instructions Concerning unity of Invention, pp. AI-53—AI-57.

If any [further] extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this paper, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 19-0741.

APPENDIX: VERSION WITH MARKINGS TO SHOW CHANGES MADE

71. (Amended) A method of allosterically inhibiting a Tat protein in a patient, comprising administering to a patient in need of such inhibition, in an amount effective to inhibit a Tat protein, a substituted aromatic compound of formula $\text{ArCH}_2\text{A}'\text{F}_a$, wherein

Ar represents [an aromatic ring chosen between a toluene compound or a condensed polycyclic aromatic hydrocarbon] **a triphenene ring**,

$\text{CH}_2\text{A}'$ represents a nonfunctionalized linear aliphatic chain comprising 1 to 8 carbon atoms or 1 to 7 carbon atoms and 1 heteroatom or 1 to 6 carbon atoms and 2 heteroatoms, and

F_a represents a substituent comprising at least one proton acceptor or donor function capable of establishing one or more hydrogen bonds,

where the triphenene compound is not substituted at the 2-position with $-\text{CH}_2\text{-NH-CH}_2\text{-CH}(\text{OCH}_3)_2$ or $-\text{CH}_2\text{-NH-C}(\text{CH}_3)(\text{CH}_2\text{OH})_2$.